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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,054	07/23/2001	Mayumi Tomikawa	522.1921D	4839

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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

MORAN, MARJORIE A

ART UNIT PAPER NUMBER

1631

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/910,054	<b>Applicant(s)</b> TOMIKAWA ET AL.	
	<b>Examiner</b> Marjorie A. Moran	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-7,9,11,21 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-7,9,11,21 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. All objections and rejections not reiterated below are hereby withdrawn in view of the amendments and arguments filed 8/2/06.

***Claim Rejections - 35 USC § 112***

Claims 5-7, 9, 11, 21, and 24-27 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's arguments filed 8/2/06 have been fully considered but they are not persuasive. The arguments are addressed as they pertain to each rejection below.

Claim 5 recites the term "predetermined amino acid sequence" in its penultimate line. The term lacks antecedent basis in the claim, therefore the claim is indefinite. It is noted that a "predetermined amino acid sequence probe" is recited in the preamble, but not a "predetermined amino acid sequence."

Claims 6, 7, 9, and 11 depend from claim 5 and are therefore also indefinite.

Claims 5, 21, and 25-27 recite the phrase "candidate for the combination of correspondence..." The claims were previously rejected as it was unclear what a "point" was to be a candidate FOR. The examiner appreciates that the phrase "for the combination of correspondence" was added in an attempt to clarify the claims and address this rejection. Unfortunately, it is still unclear what sort of "candidate" is intended; i.e. as rmsd value, or an attribute value, or a point from one or both of the

point sets recited in the preamble, or a three-dimensional coordinate, etc., therefore the claims are still indefinite.

Claims 6, 7, 9, 11, and 24 depend from claims 5 and 21 and are therefore also indefinite.

Claim 9 recites that a combination of correspondence satisfy a “threshold value condition.” It is unclear if the “threshold value condition” is intended to be the same as the “predetermined threshold value” of parent claim 5, or if a different threshold is intended. It is noted that parent claim 5 recites that the “predetermined threshold value” is one against which an “attribute value” is compared, not one against which an entire “combination of correspondence” is compared. Further, while the explanation of a “threshold value” set forth in the response of 8/2/06 is persuasive, the specification does not appear to defined or exemplify a “threshold value *condition*” such that this term is clear, therefore applicant’s arguments with regard to threshold values as set forth in the response filed 8/2/06 are not persuasive with regard to the “threshold value condition.”

Claims 11 and 24 limit generating a combination of correspondence to be based on a “condition” such that attribute values of elements belonging to a first point set coincide with attribute values of corresponding elements belonging to a second point set in a candidate for the combination of correspondence. However, parent claims 5 and 21 recite, in a step of generating a combination of correspondence, determining if a point is a candidate for the combination of correspondence if an attribute of an element of the first point set coincides with an element of the second point set, then “refining” elements based on the coinciding attributed, thus the determination of coincidence is

necessarily performed for multiple elements. As the limitations of claims 11 and 24 appear to be merely a rewording of the step of determining a coincidence between attributes of elements recited in their respective parent claims, it is unclear what further limitation of the parent claim is intended in each of claims 11 and 24. As it is possible that claims 11 and 24 intend an additional step of determining a coincidence, and it is unclear what limitation is actually intended, claims 11 and 24 are indefinite.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Monday-Friday; 6 am-2:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571)272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marjorie A. Moran  
Primary Examiner  
Art Unit 1631

*Marjorie A. Moran*  
10/15/08